

**REMARKS**

Claims 1-11 and 13-28 are pending in this application. Claims 1, 2, 8, 10, 11, 13-15, 17, 20, 22 and 25 are amended and new claim 29 is added herein.

Claims 1, 10, 11, 16, 22 and 28 are independent.

Claims 2, 17 and 25 are amended solely to delete unnecessary limitations and add disclosed limitations (see, for example, page 19 of the subject application), not previously recited in these claims. The added limitations further distinguish over the applied prior art, however, the amendment of these claims is not for purposes of patentability over the prior art of record or otherwise, since these claims, as discussed below, were allowable without modification.

Claim 8 is amended solely for clarification and not for purposes of patentability.

Claim 20 is subject to a non-narrowing amendment solely to correct a minor informality.

Claims 13-15 are amended solely in view the amendment to their parent claim 11.

Claim 29 is added to recite not previously recited but disclosed limitations (see, for example, page 19 of the subject application) that further distinguish over the applied prior art.

The Examiner's notice of the allowability of the claim 28 subject matter over the prior art is noted with appreciation. Since no art is applied against claim 14, it is understood that this claim is also deemed to recite subject matter allowable over the prior art.

The courtesy of the Examiner Interview on September 24, 2002, and documented in the Examiner's Interview Summary of the same date, is also noted with appreciation. This response is consistent with the discussions at that Interview.

As discussed during the interview, the references to an Interview on February 14, 2002, i.e. the first two sentences on page 4 of the Official Action to which this response relates, are incorrect and should be acknowledged as such, and stricken in the next official action.

The specification is objected to because of informalities. The related applications section of the specification is amended to address the noted concerns.

The drawings are objected to under 37 CFR §1.83(a). Amendment of Figure 3 is proposed herein to incorporate a zip code identifying step 63 in the depicted flow chart, as discussed, for example, on page 19 of the present application. The specification is also accordingly amended to add reference numeral 63 in the text relating to Figure 3. No new matter is added.

Claims 1-11 and 13-28 stand rejected under 35 USC § 112, first paragraph, as indefinite. The rejection is respectfully traversed.

The Examiner notes that independent claims 1, 10, 16 and 21 all recite, *inter alia*, processing the payee address information to "identify" an eleven digit zip code, and that independent claims 11 and 22 recite, *inter alia*, processing payee information and address information respectively to "produce" an eleven digit zip code. The Examiner asserts that the only teaching on how an eleven digit zip code is "identified" or "produced" in the originally filed disclosure is found on page 19, lines 6-11. The

Examiner further contends that in view of an article entitled "History of the U.S. Postal Service" that the specification teachings lack the disclosure of essential elements needed to generate an eleven digit zip code. The Examiner further argues that the specification as originally filed also lacks written description to provide support for claims reciting the identification or production of an eleven digit zip code for a payee based on, for example, payment information other than a received payee zip code.

An analysis under 35 U.S.C. §112 begins with the determination of whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. Claim language is not viewed in a vacuum, but in light of the teachings of the prior art and of the application disclosure as it would be understood by one possessing the ordinary level of skill in the art. (See, for example, In re Johnson, 194 USPQ 187(CCPA 1997); In re Moore, 169 USPQ 236 (CCPA 1971)). It is also well established that under 35 USC §112, first paragraph, the disclosure, including the specification, claims and drawings as originally filed must be considered in terms of what they reasonably convey that the inventor had possession of at the time of the original filing. Thus, the claims serve as their own written description (See, for example, In re Baker, 194 USPQ 470 (CCPA 1977) and In re Wertheim, 191 USPQ 90 (CCPA 1976)).

With regard to the written description and enablement of "identifying" or "producing" of an eleven digit zip as recited in independent claims 1, 10, 11, 16 and 22, it is respectfully submitted that the application as originally filed provides a written description of the general processing of payment information, excluding a

payee's zip code, to identify or produce an eleven digit zip code for a payee. For example, support for this feature can be found in originally filed claim 1.

With respect to enablement, as discussed at the interview, the present invention has been implemented utilizing well known commercial software which maps information associated with an entity to an eleven digit zip code and thereby "identifies" or "produces" an eleven digit zip code. Code-One is a well known product which was available commercially at the time of filing this application, and performs such mapping, as would be well understood by those skilled in the art. Hence, use of the particular methodology utilized by the U.S. Postal Service in originally developing the eleven digit zip code is unnecessary to implement the claimed invention and accordingly is not of relevance. Rather, those skilled in the art would have recognized at the time of the invention that products such as Code-One can be utilized to identify a zip code as claimed in the subject application. Furthermore, as disclosed and hence recognized by the inventors at the time of the filing of the present application, the eleven digit zip code may be identified based on a merchant name, city and state or on other information. Thus, as disclosed in the application as filed, and what the inventors seek protection on is their discovery that in order to identify a payee, it is advantageous to identify a zip code for the payee using information other than a zip code which is provided by a payor, without limitation as to the particular type of payor provided information which is utilized to identify the zip code. Accordingly, it is respectfully submitted that the invention as claimed is both fully disclosed and enabled by the specification, as originally filed, and therefore meets the requirements of 35 USC §112 (first paragraph).

Claims 1, 2, 4-11 and 13-28 stand rejected under 35 USC §112, second paragraph, as indefinite. The preambles of independent claims 1, 10 and 11 are amended herein to address certain of the noted concerns. To the extent not addressed by such amendment, the rejection is respectfully traversed.

The Examiner asserts that the recited limitations of various claims are indefinite because the recited limitations are broader than that which is disclosed in the specification. However, as discussed above in detail, the inventors have claimed that which has been disclosed in the originally filed application. It is irrelevant what information, other than the submitted payee zip code, is utilized to identify a zip code for the payee. Rather, as described in the application as originally filed, what is relevant is that only information, other than a submitted payee zip code, is utilized to identify a payee zip code which is then used to access payee information.

Claims 1-5, 8, 10, 11 and 15-20, 22-23 and 25-27 stand rejected under 35 USC § 102(e) as anticipated by Haimowitz et al. (U.S. Patent No. 5,819,291). Claims 6, 7, 9, 13, 15, 21 and 24 stand rejected under 35 USC § 103(a) as obvious over Landry. (U.S. Patent No. 5,649,117) in view of Haimowitz et al. Claim 22 is amended in view of the applied prior art. To the extent not addressed by such amendment, the rejection is respectfully traversed.

Independent claims 1, 10, 11, 16 and 22 will be first addressed.

Haimowitz discloses a technique for first validating and normalizing received data, and then using this data to enter an existing database to determine if existing data matches the newly received data. As discussed in the Examiner referenced text in

columns 3 and 4, the validation processing includes a verification of a received zip code. If a zip code is not received, the zip code is dubbed if possible using a submitted city and state, and the zip code table from the U.S. Postal Office. It should be noted that Haimowitz does not in any way suggest that if a received zip code is deemed to be invalid it should be dubbed. Rather, Haimowitz explicitly discloses that a zip code will be dubbed or derived from the U.S. Postal Office zip code table only if a city and state, without a zip code, are included in the received record.

Haimowitz also discloses that if the data in the fields are bad (e.g. a received zip code cannot be validated) then the record is removed from consideration and placed in the pending file 22. Explicitly disclosed is that if part of the postal code (zip code) cannot be used as a hash key, for example if a received zip code were deemed invalid, then the data is bad and placed in a bad data file for future resolution.

Hence, according to Haimowitz, only if a received zip code is validated, is the received zip code utilized for matching. If the received zip code cannot be validated, it is not normalized and the received record is removed from further consideration and placed in the pending file.

On the other hand, if the received record includes only a city and state (i.e., there is no received zip code) a zip code will be derived using the U.S. Postal Office zip code table. Since only the city and state are used, as the Examiner notes in his discussion of the U.S. Postal Service's development of the zip code, it would be impossible for Haimowitz to derive an eleven digit zip using the disclosed technique. In any event, where no zip code has been provided but one can be derived, the data will also be

validated and utilized for matching.

Accordingly, Haimowitz lacks any teaching, or for that matter suggestion, of processing received information, other than a received payee zip code, to identify an eleven digit zip code for a payee as required by claim 1. The applied reference also fails to teach or suggest processing a name, along with city and state information, to identify an eleven digit zip code as required in claim 10 of the present application. In this regard, it is perhaps worthwhile to again note that Haimowitz explicitly discloses utilizing only city and state information to derive the zip code, and therefore is incapable of deriving an eleven digit zip code, although the use of eleven digit zip codes was well known in 1996 when Haimowitz filed the application which matured into the applied patent.

Additionally lacking is a processor configured to process received information, excluding a received payee zip code, to produce an eleven digit zip code for the payee as required by claim 11. The applied reference also lacks a computer program which causes a computer to operate so as to process received information, excluding a received payee zip code, to identify an eleven digit zip code for the payee, as required by claim 16. Finally, the applied patent lacks any teaching or suggestion of a second station which receives information including the payee name and the payee address data, and produces an eleven digit zip code for the payee as required by amended claim 22. Accordingly, it is respectfully submitted that each of the independent claims patentably distinguishes over the applied prior art.

In summary, Haimowitz recognized the problem of a received zip code being incorrect. According to Haimowitz, if a zip code is included in the received data,

Haimowitz attempts to verify the zip code, and utilizes the received zip code in the matching process if it is verified. However, if the received zip code cannot be verified, the received data is not processed for matching, but is instead removed to a pending file for later resolution, since (presumably) Haimowitz does not know whether received city and state information or the received zip code is incorrect. On the other hand, where a city and state are included, but a zip code is not included, in the received data, a zip code (although not an eleven digit zip code) can be derived using the postal service zip code table and utilized for matching. Hence, although Haimowitz recognized that received zip codes may be incorrect he failed to recognize the benefit to be obtained from ignoring received zip codes altogether and relying on the other received information to derive an eleven digit zip code for matching. Furthermore, Haimowitz also failed to recognize the benefit of using information necessary to derive an eleven digit zip code.

Thus, Haimowitz seeks to solve a similar problem to that of the present invention in a substantially different way, and at best teaches away from the solution described and claimed in the subject application (See, for example, In re Bell, 26 USPQ 2d 1529 (Fed. Circ. 1993) and In re Marshall, 198 USPQ 344 (CCPA 1978).

Other features recited in the dependent claims further and independently distinguish over the applied prior art. For example, claim 2 (as amended) requires that the received payment information, which is processed to identify the eleven digit zip code for the payee, include payee name information. As discussed above, Haimowitz lacks any teaching or suggestion of identifying an eleven digit zip or utilizing a name to



identify a zip code. Rather, Haimowitz derives a zip code using only city and state information and accordingly, is incapable of identifying an eleven digit zip code.

Further, Haimowitz derives a zip code only when a zip code is not received with the city and state information.

As clarified herein, claim 8 transforms the verified account number into an altered account number according to the alteration rules corresponding to the payee. As noted by the Examiner, Haimowitz only normalizes data. Hence to the extent that Haimowitz common normalization rules can be considered alteration rules, they do not correspond to any particular entity.

Claim 9 requires that a payee have a plurality of remittance centers and that the received account number be processed to identify the particular one of these remittance centers to which payment is to be remitted.

The Examiner contends that "it is notoriously old and well known in the art that merchants (i.e., payees, in this sense) have multiple banks that provide financial administrative services. Consequently systems such as Landry, which deals with multiple payees and payors, set up a system that will look up a specific "payee" (i.e., the financial institute, in this sense) to accept the payment for a payor. That is to say, it is irrelevant whether a "payee" (i.e., a merchant) has multiple remittance centers. Landry teaches that a payor's account number (i.e., record ID) is processed to determine who is to receive the payment (i.e., payee ID) for the merchant and directs payment to the identified entity."

The Examiner's rationale is not understood. Landry lacks any disclosure

whatsoever regarding the selection of one of multiple payment remittance centers for a particular payee, and the Examiner has not cited any section of Landry as disclosing such a selection. The relevance of the Examiner's reliance on the fact that merchants may historically have had multiple banks is unclear. Remittance centers receive remittance advice, while financial institutions ultimately receive the payments. Further, whether a payee has multiple remittance centers is clearly relevant in the context of a payment system, otherwise remittance advice may be misdirected to the wrong payee remittance center and hence payments are not properly accounted for.

The Examiner asserts (without any support whatsoever) that Landry teaches a payor's account number (i.e., record ID) is processed to determine who is to receive the payment (i.e., payee ID) for the merchant and directs payment to the identified entity. Even if this were disclosed, this would clearly suggest that Landry contemplates only a single payment center for each payee, and hence has not even considered the potential problem in making remittance to payees, let alone remittance to payees having multiple remittance centers (e.g. the Internal Revenue Service). Even if Landry had recognized such a possibility, according to the disclosed system, Landry's database could not associate a single payee in a database with multiple different remittance centers, since Landry makes no selection in the course of the described processing. Haimowitz also lacks any such disclosure and has not been applied in this regard. Accordingly, it is respectfully submitted that claim 9 clearly distinguishes over the applied prior art.

Claims 12, 14, 15, 17, 20, 21, 23, 24, 25 and 29 also patentably distinguish over the applied prior art for reasons which should be clear from the above.

It is further respectfully submitted that there is no motivation to combine Haimowitz with Landry as proposed by the Examiner. First, it is not at all clear that a zip code could be utilized to access Landry's database, and the Examiner has failed to provide any reasonable explanation as to how those teachings of Haimowitz which the Examiner argues as relevant to the present claims could be utilized by Landry.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

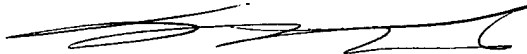
Docket No.: 3350-001  
File No.: 1158.41320X00  
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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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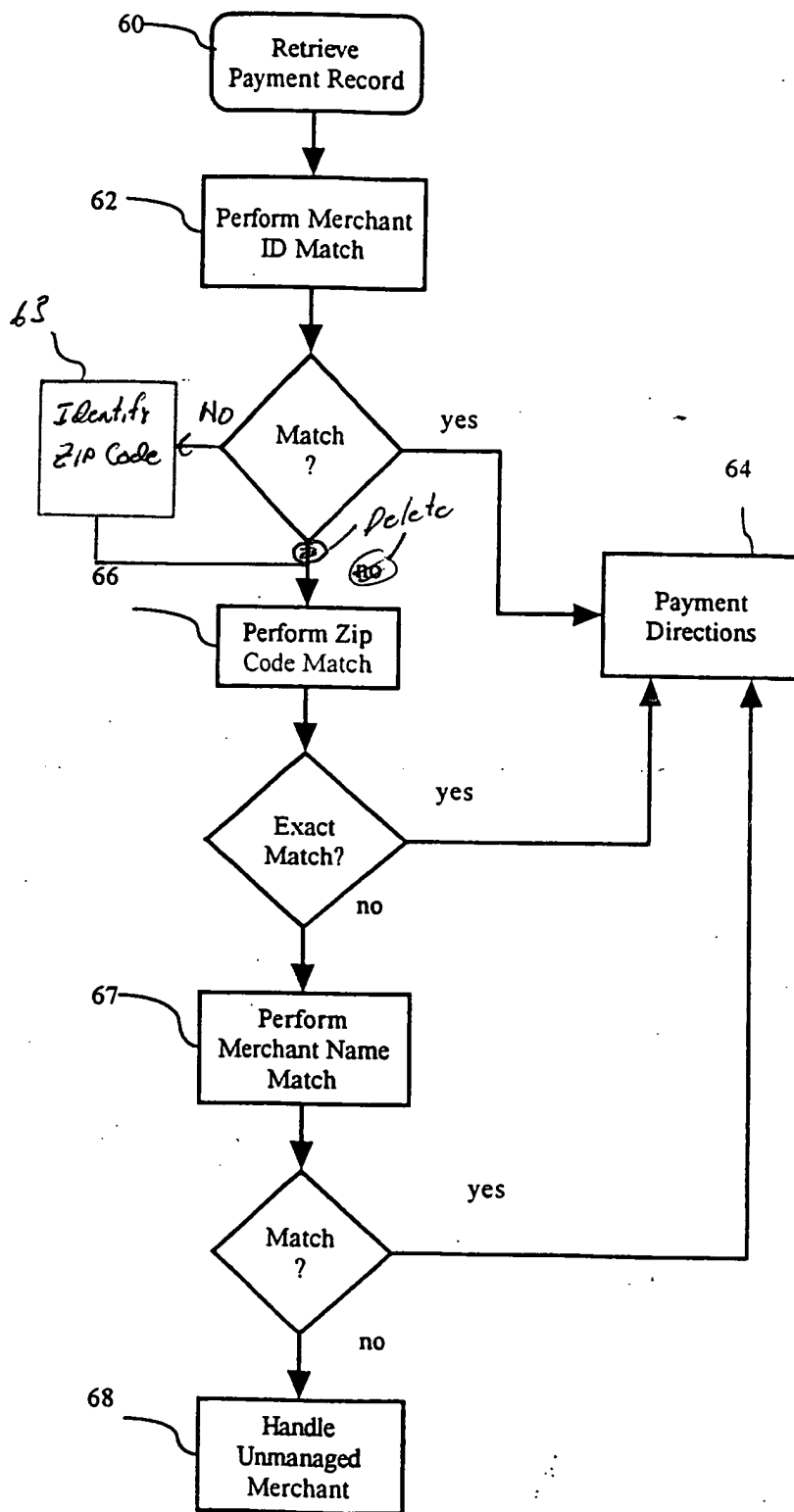


FIGURE 3